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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/220,910	12/24/98	WALSH	T 2207-6033

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TM31/0831

EXAMINER

VU, T

ART UNIT

PAPER NUMBER

2152

2

DATE MAILED:

08/31/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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TM02/0703

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EXAMINER

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Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/220,910

Applicant(s)

WALSH, THOMAS E.

Examiner

Thong H Vu

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2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 December 1998.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

1. Claims 1-9, 12-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Krause [5,526,520].

2. As per claim 1, Krause discloses a method for identifying a secondary document relative to a primary document comprising: determining if said primary document includes an indicator; and identifying said secondary document if said primary document includes said indicator [col 9 line 28-col 10 line 5].

3. As per claim 2, Krause discloses attaching said secondary document to said primary document if said primary document includes said indicator [col 10 lines 6-27]

4. As per claim 3, Krause discloses said secondary document has a filename and a location, the method further comprising determining at least one of said filename and said location of said secondary document [col 6 lines 35-45].

5. As per claim 4, Krause discloses said secondary document has a filename and a location, the method further comprising determining at least one of said filename and said location of said secondary document as a function of a user input [col 6 lines 35-45].

6. As per claim 5, Krause discloses said primary document includes at least one word, and wherein determining at least one of said filename and said location of said secondary document is performed as a function of said at least one word as a design choice of frame name [col 6 line 35-col 7 line 28].

7. As per claim 6, Krause discloses said primary document includes a plurality of words, and wherein determining at least one of said filename and said location of said secondary document is performed as a function of said plurality of words within a predetermined proximity

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of said indicator included in said plurality of words as a design choice of frame name [col 6 line 35-col 7 line 28].

8. As per claim 7, Krause discloses associating a predetermined word with at least one of said filename and said location of said secondary document, wherein said primary document includes said predetermined word, and wherein identifying at least one of said filename and said location of said secondary document is performed as a function of said predetermined word as a design choice of frame name [col 6 line 35-col 7 line 28].

9. As per claim 8, Krause discloses said indicator includes at least one of a plurality of predetermined words, a plurality of predetermined characters, and a plurality of predetermined phrases as a design choice of frame name [col 6 line 35-col 7 line 28].

10. As per claim 9, Krause discloses determining if said at least one word includes one of said indicator is performed using syntactic processing or menu [col 6 line 35-col 7 line 28].

11. As per claim 12, Krause discloses sending said primary document and said secondary document attached thereto to a printing device [Krause col 2 line 48]

12. As per claim 13, Krause discloses said primary document and said secondary document attached thereto to a recipient via facsimile or scanner [Krause col 2 line 48]

13. As per claim 14, Krause discloses said secondary document is attached to said primary document at a first instance, said first instance being determined as a function of a user input [Krause col 6 lines 35-45].

14. As per claim 15, Krause discloses adding at least one additional indicator to said indicator as a function of a user input [Krause col 6 lines 35-45].

15. As per claims 16-30 contain the similar limitations set forth of method claims 1-9, 12-15. Therefore, claims 16-30 are rejected for the same rationale set forth claims 1-9, 12-15.

16. Claims 10-11 are rejected under 35 U.S.C. § 103 as being unpatentable over Krause [5,526,520] in view of Narasimhan et al [Narasimhan 6,073,165]

As per claim 10, Krause is silent to disclose said primary document includes an email message. However Narasimhan discloses a message processing system including the first message which is further processed to create a second message such as an email message with file attachment [Narasimhan col 1 lines 40-60, col 5 lines 3-17].

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Krause and Narasimhan's teaching. By doing so it would provide the fast and easy way to send the document to client through a large network such as Internet.

17. As per claim 11, Krause-Narasimhan disclose sending said e-mail message and said secondary document attached thereto to a recipient via a communications device [Narasimhan col 1 lines 40-60, col 5 lines 3-17].

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong H Vu whose telephone number is 703-305-4643. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart can be reached on 703-305-4815. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-6606 for regular communications and 703-308-6606 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-9700.

Thong Vu
July 1, 2001

A handwritten signature in black ink, consisting of several loops and a long horizontal stroke at the end.

MARK H. RINEHART
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100